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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,873	03/08/2004	Jean-Pierre Hermet	1049-04	3189

35811 7590 07/15/2005

IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
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PHILADELPHIA, PA 19103

EXAMINER

HINES, JANA A

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/795,873

Applicant(s)

HERMET ET AL.

Examiner

Ja-Na Hines

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-28 are drawn to a method for detecting contaminating microbes, classified in class 435, subclass 7.4.
 - II. Claims 29-36 are drawn to a device for concentrating contaminating microbes, classified in class 435, subclass 297.1.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the device only concentrates microbes and does not detect the microbes. Therefore the device could be used with a materially different process, such as a method for concentrating microbes, and not with a method of detection.

Alternatively, the method of detection can be practiced by hand or with other filtration and detection devices. Thus, the inventions are materially distinct since it has been shown that they can be practiced with materially different processes or apparatuses.

Searching the inventions of Groups I and II together would impose serious search burden. The inventions of Groups I and II have acquired a separate status in the art as shown by their different classifications. Moreover, in the instant case, the search for the method of detection and an apparatus comprising a first and second watertight, a

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sterile tank, two filters and a connector are not coextensive. The search for group I would require a text search drawn to the method of detecting contaminating microbes and the prior art which teaches that method would not necessarily be applicable to a teaching of an apparatus comprising two watertight, a sterile tank, two filters and a connector. Moreover, even if the apparatus were known, the method of detection may be novel and unobvious in view of the preamble or active steps.

3. Because these inventions are distinct for the reasons given above; have acquired a separate status in the art as shown by their different classification; and have divergent subject matter, the search required for Group I is not required for Group II, thus restriction for examination purposes as indicated is proper.

Species Election

4. Claims 1-28 of group I are generic to a plurality of disclosed patentably distinct species comprising:

A) Claim 9 recites an aggregation agent selected from:

1) a specific antibody of a platelet antigen, therefore if the specific antibody of a platelet antigen is chosen than claims 10 and 13 will also be examined;

2) a strong agonist, therefore if the strong agonist is chosen than claim 11 will also be examined; and

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3) a weak agonist, therefore if the weak agonist is chosen than claim 12 will also be examined.

Therefore, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

B) Claim 14 recites an agglutination agent selected from:

1) lectins, therefore if lectins is chosen than claims 15-17 will also be examined;

2) polyethylene imine, therefore if polyethylene imine is chosen than claim 18 will also be examined;

3) polyvinylpyrrolidone, therefore if polyvinylpyrrolidone is chosen than claim 19 will also be examined;

4) gelatins, therefore if gelatin is chosen than claim 20 will also be examined;

5) dextrans, therefore if dextrans is chosen than claim 21 will also be examined; and

6) polyethylene glycols, therefore if polyethylene glycols is chosen than claim 22 will also be examined.

Therefore, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

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5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is 571-272-0859. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ja-Na Hines
July 1, 2005

